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EXAMINER

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ART UNIT	PAPER NUMBER
3711	

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17

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/650,843

MAILED

Filing Date: 8/28/00

APR 22 2003

Appellant(s): SOVINE ET AL.

GROUP 3700

Frank W. Compagni
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/27/2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the claims, as grouped on pages 6 and 7 of the brief, do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8) with the exception of claim 16. Therefore claim 16 is presumed to stand or fall with claim 14.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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4,787,289	Duer	11-1988
94/27111	Fumero	11-1994

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 5, 7, 10, 14, 15, 17, 18, 20, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Duer.

Claims 1, 2, 6, 10, 12, 13, 14, 15, 17, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Fumero.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duer.

Claims 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fumero.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabler.

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duer in view of Fumero.

These rejections with the exception of the claim 2, 5, and 6 rejections under 35 U.S.C. 102(b) over Fumero are set forth in prior Office Action, Paper No. 7.

Regarding claim 2, upon further review of Fumero it is apparent that claim 2 is anticipated at page 9, second full paragraph.

Concerning claims 5 and 6, upon further review of Fumero it is apparent that claim 6 is anticipated at page 9, last paragraph and Fig. 7.

The rejection of claims 3 and 4 has been withdrawn and these claims are considered allowable over the prior art of record.

(11) Response to Argument

Appellant's first argument is that Duer and Fumero do not disclose an insert having an opening for receiving a gun barrel formed of a bullet decelerating material.

First with regard to Duer attention is directed to Duer's basket member 104 which is considered the insert. Duer's basket opening is capable of receiving the barrel of a gun and the mesh would to some degree decelerate a bullet.

With regard to Fumero note Fumero's Fig. 22-24 device and removable bullet deceleration chamber 20 which is considered the insert. Fumero's insert opening is capable of receiving the barrel of a gun.

Appellant next argues that neither reference discloses an opening at one end through which the insert is inserted. No such limitation is claimed. The claim requires the insert to be slidably insertable and removable from the void in the housing which both the Duer and Fumero inserts are capable of. Both inserts are taught as being removable so that they may be emptied of projectiles.

Regarding the argument advanced in the first full paragraph on page 9 of the brief the examiner has not suggested in the claim 1 rejection any "obvious" feature. Such an analysis does not come into play under 35 U.S.C. 102.

With regard to the claim 14 arguments again Duer's basket opening is capable of receiving the barrel of a gun and the mesh would to some degree decelerate a bullet.

As to Fumero compartment 105 itself may be considered the housing. The examiner has not suggested that compartment 105 is considered the insert. Element 20 is considered the insert. The examiner has not used a "pick and choose" analysis in analyzing claim 14 under 35

U.S.C. 102. In both appellant's device, Duer's device, and Fumero's device there is a removable bullet decelerating element received inside a housing. Appellant terms this element the insert and the examiner has merely followed appellant's terminology in identifying the like elements of the prior art devices.

Concerning the claim 20 argument, both Duer's insert is to be removed from the housing to be emptied as noted above. Duer specifically describes the process of sliding his insert out of the housing. Fumero has not been applied against this claim. As to the "deceleration" limitation note the examiner's above comments.

Regarding the claim 7 argument, any of Duer's openings in the mesh plate may be considered the "at least one slot".

With regard to the claim 13 argument, Fumero nowhere mentions the use of plate steel to form the cabinet and such would clearly have not been necessary given that the ballistic duct C uses ballistic steel plate. Moreover, at the very least the sound proofing portions 108 of the housing are not formed of steel as can be seen by observing their cross-section in Fig. 23.

Concerning the claim 15 argument, both Duer's and Fumero's inserts are removable as noted above. Duer's insert is specifically described in a slidably removable fashion and Fumero's is capable of being slid as it is removed. Again for purposes of 35 U.S.C. 102 the examiner has not suggested that any element other than element 20 is considered the insert.

Appellant's next argument concerns the rejection under 35 U.S.C. 103 based on Fumero. It is appellant's position that because the examiner interpreted the claims in one manner under 35 U.S.C. 102 they cannot be interpreted in another manner under 35 U.S.C. 103. Appellant has offered no support for this position. There are no contradictions in the manner in which the

examiner has interpreted the prior art in light of the claims. Appellant's claims are of such breadth that the prior art may be read on them in more than one way. The examiner is obligated under the law to give the claims their broadest possible interpretation. The examiner has identified two ways in which the prior art meets the claim language. (It is not clear where appellant finds a third interpretation). The only way such a rejection would be contradictory would be if the examiner under a single grounds of rejection identified elements in a contradictory manner.

Moreover, with the removal of the rejection of claims 3 and 4 and the rejection of claims 2, 5, and 6 under Fumero it would appear that appellant's argument is moot.

As to appellant's argument over claim 6, Fumero teaches a rectangular insert 20. One of the four plates which makes up the rectangular structure may be considered the top plate, just as one appellant's four plates which make up his rectangular insert is considered the top plate by appellant.

Concerning the claim 8 and 9 rejection appellant's statement that the examiner indicated the "subject matter" of claims 8 and 9 as allowable is false. The examiner indicated in the first office action that claims 8 and 9 including their limitations and those of the base claim and any intervening claims would be patentable. Appellant chose not to present such a claim for patentability. The currently claims 8 and 9 are not any more relevant to the originally presented claims 8 and 9 than any other claims presented for appeal. Therefore, the finality of the second action was proper.

Furthermore, any question as to prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question

of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 C.F.R. 1.181. See MPEP 1002.02(c).

As to appellant's substantive argument over the rejection of claims 8 and 9 over Tabler, but for the recited "slots" for which no function is claimed, Tabler anticipates the claim 8 and 9 rejection. The term slots as defined in the dictionary is broad enough to encompass mere holes. Thus, all appellant has claimed is Tabler's device with holes in its bottom plates. While there may have been various reasons to place holes in Tabler's plates it is only necessary that one obvious reason have been present for the ordinarily skilled artisan. Here, as noted by the examiner holes are commonly used in steel to fasten elements together. One of ordinary skill in the art would obviously have recognized that such holes/slots could have been used for mechanical fasteners such as rivets to fasten Tabler's plates 40 and 50 to the insert.

Appellant's response that such plates are normally fastened by "welding" and that it is "unlikely" that the plates in such a manner is unsupported and in any event misses the point. Whether or not such a method is used in the art if another method would have been obvious this is all that matters. The rejection at hand is not an anticipation rejection. The examiner considers it within the skill of one of ordinary skill in the art to have considered mechanical fasteners requiring holes/slots to fasten plates 40 and 50 of Tabler.

As to the claim 9 argument it is apparent in observing Tabler that any holes/slots used to fasten Tabler's plates would necessarily have not been aligned and thus would not have overlapped.

Appellant's final argument concerns claims 23-25. As noted by the examiner in the claim 23 rejection Duer discloses the claimed device with the exception of a steel plate for his bottom plate 108. However Duer does note that any suitable material may be used to form his insert. (Col. 6, lines 25-28). Fumero provides a clear teaching that steel plate is an appropriate material for such inserts and that multiple bottom plates may be used. Appellant's argument that steel plate would not have been obvious because it would not have allowed the sifting of Duer's particles 16 is not persuasive. The ordinarily skilled artisan is not presumed to work in a vacuum and would have obviously have provided openings in any steel plate appropriate to provide this function of Duer.

Regarding the "releasably attached" at least one piece of steel, as the examiner noted in the claim 16 rejection it would appear that Fumero teaches the removability of his bottom plate 30 and that even if this were not the case it would have been obvious to the ordinarily skilled artisan to have made it so removable so that it could have been replaced from time to time.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as noted above the knowledge generally available to one of ordinary skill in the art would have included the knowledge to provide parts of the Duer/Fumero device as releasably attached to provide for replacement as needed.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark S. Graham

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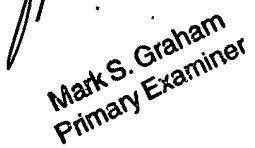
April 20, 2003

Conferes:



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